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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,317	10/20/2000	Kia Silverbrook	ART85US	8404

24011 7590 07/16/2007  
SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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LETT, THOMAS J

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/693,317	Applicant(s) SILVERBROOK ET AL.	
	Examiner Thomas J. Lett	Art Unit 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 September 2006 has been entered.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3,4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton et al (US 6,304,345) and Patton et al (US 6,894,794) in view of Mui (US 6,160,642) in view of DeClerck et al (USPN 6,437,849 B1).

Regarding claim 6, Patton '345 teaches an apparatus (system of figure 3) for reproducing a visible image (image 12, figure 1) depicted in a photograph (print 10, figure 1), the photograph also carrying digitally encoded data (code 16, col. 5, lines 6-9, see figure 1), the apparatus comprising:

a scanner means (digital scanner 30, col. 9, line 66) for scanning the digital data to produce a bit image with a plurality of copies of data relating to the visible image depicted in the photograph (the system of Patton '345 can obviously make more than one scan/copy of an original;

Art Unit: 2625

means for illuminating the photograph with invisible radiation (inherent properties of scanning, all scanners must have light illuminating the photograph, also see column 8, lines 5-10);

means for processing data output from the scanner means, the means for processing data including means for decoding the digitally encoded data scanned by the scanner means (the device that decodes the code of column 5, lines 5-15 that is used for reprinting image 12); and

inkjet printer means (column 4, lines 45-50, 47, fig. 3) for receiving data from the means for processing data (e.g., 39, fig. 3) to print the visible image depicted in the photograph (12, fig. 1, column 5, lines 5-15), the data used to print the visible image being generated using the digitally encoded data; wherein during use, the means for decoding decodes one of the copies of the data relating to the visible image if decoding of the previous copy failed (the system of Patton '345 can obviously make more than one scan/copy of an original and can subsequently attempt to repeat the process until it is successful with a latter copy).

Patton '345 does not teach the scanner means having a scan resolution greater than the print resolution of the digitally encoded data.

However, DeClerck et al teach of a scanner preferably having a scan resolution greater than a print resolution (see col. 3, lines 32-34).

Patton '345 does not teach the digitally encoded data are printed with invisible ink.

However, Patton 794, teaches it is desirable to improve Patton 345 by printing the digitally encoded data with invisible ink (column 1, lines 29-39, 09/211,232 of Patton 345 which is incorporated by reference; column 3, lines 15-25).

Patton '345 does not disclose an ADF for advancing the photograph.

Art Unit: 2625

However, Mui in the same area of scanning photograph (column 3, lines 43-45), teaches it is well known in the art to provide an ADF for advancing print media (column 1, lines 60-66).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Patton to include: an ADF for advancing the photograph.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Patton by the teaching of Mui because it would have saved users a lot of effort of advancing the photograph manually.

Regarding claim 3, Patton '794 teaches an apparatus as claimed in claim 6 wherein said invisible ink is an infra-red absorbing ink (column 3, lines 15-20), and wherein said invisible radiation is infra-red light (column 4, lines 60-67, column 5, lines 1-3).

Regarding claim 4, Patton '794 teaches an apparatus as claimed in claim 6 wherein said ink jet printer means includes means for printing out on a print media attached to said ink jet printer means both the visible image depicted in the photograph and the digitally encoded data (column 1, lines 54-58 794 teaches code 16 and image 12 are printed at same time; the examiner views the print means that prints the code 16 and image 12 as the inkjet printer means).

3. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton et al (US 6,304,345) and Patton et al (US 6,894,794) in view of Mui (US 6,160,642) in view of DeClerck et al (USPN 6,437,849 B1) as applied to claim 6 above, and further in view of Zhang (US 5,771,245).

In accordance with claims 2 and 5, Patton does not disclose expressly that the digitally encoded data is encoded and decoded using the Reed-Solomon process.

Art Unit: 2625

Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4 lines 18-20).

Patton and Zhang are combinable because they are from the same field of endeavor, namely two-dimensional data encoding and decoding. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the encoding/decoding process in Patton's system.

The motivation for doing so would have been that the Reed-Solomon process is a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2625

Thomas Lett  
AU 2625

A handwritten signature in black ink, appearing to read 'Thomas Lett', written in a cursive style.A handwritten signature in black ink, appearing to read 'David Moore', written in a cursive style.

**DAVID MOORE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**